

REMARKS

Claims 13, 14, 18-28, 31 and 32 have been cancelled, and Claims 1, 15, 16, 29, and 33-35 have been amended, to place the above-referenced application in condition for allowance. In view of these amendments and the following reasoning for allowance, the applicants hereby respectfully request further examination and reconsideration of the subject application.

The Section 101 & 112, Second Paragraph, Rejection of Claim 18

Claim 18 was rejected under 35 USC 101 and 35 USC 112, second paragraph. While no admission is made that the rejected claim is actually non-statutory subject matter or indefinite, the applicants have chosen to cancel the claim to further the prosecution of the application and expedite its allowance.

The Section 102 Rejection of Claims 1-4, 6, 8, 10, 11, 13, 16-19, 21, 23, 25, 28, 29, 31, and 34-37

Claims 1-4, 6, 8, 10, 11, 13, 16-19, 21, 23, 25, 28, 29, 31, and 34-37 were rejected under 35 USC 102(e) as being anticipated by Holtzman et al. (U.S. Patent Application Publication No. 2002/0062368). The Office Action asserts that Holtzman discloses each and every element of the applicant's claimed invention. In response, the applicants have amended the rejected claims to make them novel over the teachings of this reference.

More particularly, independent Claim 1 was amended to incorporate the subject matter of Claims 13 and 14; independent Claim 29 was amended to

incorporate the subject matter of Claims 31 and 32; and independent Claim 35 was amended to incorporate subject matter similar to that incorporated into Claims 1 and 29. As Claims 14 and 32 were rejected under 35 USC 103(a) over Holtzman in view of Nielsen (U.S. Patent No. 5,948,054), this in effect indicates the Examiner's belief that the subject matter of these claims is not taught in Holtzman. Thus, the amended claims are now patentable over Holtzman. As for Claims 2-17 and Claims 30-34, these are dependent from amended Claim 1 and Claim 29, respectively. As such they are also now patentable over Holtzman. As for Claims 18-28, these claims have been cancelled. While no admission is made that the cancelled claims are actually anticipated by Holtzman, the applicants have chosen to cancel the claims to further the prosecution of the application and expedite its allowance.

It is further noted that the dependency of Claims 15, 16, 33 and 34 were changed to conform them to the aforementioned amendments. And finally, it is noted that the phrase "a computer-readable medium that stores computer software instructions for operating the system" was deleted from Claim 29 as it was extraneous.

A prima facie case of anticipation is established only when the Examiner can show that the cited reference teaches each of the claimed elements of a rejected claim. In this case, Holtzman lacks a teaching of the features whereby the messages are tagged or identified when they are posted as being a Question message type or an Answer message type, and whereby the message type identifications are provided to users, as remaining claims 1-4, 6, 8, 10, 11, 16, 17, 29, and 34-37 now claim. Thus, the rejected claims recite a feature that is not taught in cited art, and as such a prima facie case of anticipation cannot be established. It is, therefore, respectfully requested that the rejection of these remaining claims as being anticipated by Holtzman be reconsidered based on the novel claim language:

"tagging or identifying the messages when they are posted by authoring users as being of one or more selected message types comprising a Question message type indicating that a message is a question and an Answer message type indicating that a message is an answer to a Question message type; and...providing the aggregated conversation data and message type identifications to users of the computer mediated persistent conversation system".

The Section 103(a) Rejection of Claims 5, 7, 9, 12, 20, 22, 24 and 30

Claims 5, 7, 9, 12, 20, 22, 24 and 30 were rejected under 35 USC 103(a) as being unpatentable over Holtzman in view of Mintz, U.S. Patent No. 6,250,930. It is contended in the Office Action that the combined teachings of Holtzman and Mintz teach all the elements of the rejected claims, and that it would have been obvious to incorporate the Mintz teachings into Holtzman to produce the applicants' claimed invention. In response, the applicants have amended the rejected claims to make them non-obvious over the teachings of this reference.

As stated above, the applicants have added features to the remaining independent Claims 1, 29 and 35 whereby the messages are tagged or identified when they are posted as being a Question message type or an Answer message type, and whereby the message type identifications are provided to users. These features are not taught in the Mintz reference, and so cannot be part of the combined teachings of Holtzman and Mintz.

In order to deem the applicant's claimed invention unpatentable under 35 USC 103, a prima facie showing of obviousness must be made. To make a prima facie showing of obviousness, all of the claimed elements of an applicant's invention must be considered, especially when they are missing from the prior art. If a

claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

In this case, neither Holtzman nor Mintz teach the applicants' now claimed features of tagging or identifying messages when they are posted as being a Question message type or an Answer message type, or providing the message type identifications to the users. These features have the advantage of allowing a user to determine the number of questions and answers posted in a conversation to assess whether they would be interested in monitoring or joining the discussion. Thus, the applicants have claimed features not taught in the cited combination, and which have advantages not recognized therein. Accordingly, no prima facie case of obviousness can be established in accordance with the holding of *In Re Fine*. This lack of prima facie showing of obviousness means that the rejected claims are patentable under 35 USC 103(a) over Holtzman in view of Mintz. As such, it is respectfully requested that the rejection of remaining Claims 5, 7, 9, 12 and 30 be reconsidered based on the previously-quoted non-obvious claim language,

The Section 103(a) Rejection of Claims 14, 15, 26, 27, 32 and 33

Claims 14, 15, 26, 27, 32 and 33 were rejected under 35 USC 103(a) as being unpatentable over Holtzman in view of Nielsen, U.S. Patent No. 5,948,054. It is contended in the Office Action that the combined teachings of Holtzman and Nielsen teach all the elements of the rejected claims, and that it would have been obvious to incorporate the Nielsen teachings into Holtzman to produce the applicants' claimed invention. The applicants respectfully disagree.

As stated previously, independent Claim 1 was amended to incorporate the subject matter of Claims 13 and 14; independent Claim 29 was amended to incorporate the subject matter of Claims 31 and 32; and independent Claim 35 was amended to incorporate subject matter similar to that incorporated into Claims 1 and 29. It is the applicants' position that the Holtzman-Nielsen combination does not teach this subject matter. Specifically, it is the applicants' position that the combination does not teach tagging or identifying messages when they are posted as being a Question message type or an Answer message type, or providing the message type identifications to the users.

Granted, it was contended in the Office Action that Nielsen taught these features citing Fig. 8A and Fig. 11 as evidence. However, this is not the case. The section of Nielsen describing Fig. 8A reads:

"FIG. 8A is a flow diagram illustrating one embodiment for posting questions to a personal web page of a consultant. In step 801 the method receives the ordered list of consultants generated in step 707 in FIG. 7. In step 803, the method retrieves, for each consultant on the ordered list, a file which contains the personal web page for the consultant. In step 805 the method retrieves the new question from the matchmaking services web page 500. In step 807, the method stores the new question in the retrieved file. Appropriate HTML tags may be added to each file to improve readability of the new question when displayed as part of the consultant's personal web page. In step 809 the method stores the updated file on a storage medium. Upon completion of step 809 the method of FIG. 8A ends processing";

and the section describing Fig. 11 reads:

"FIG. 11 is a flow diagram illustrating the preferred steps taken to

process an answer to a customer's question. In step 1101 the method receives an answer from the consultant's personal web page. In step 1103 the method retrieves the email address of the customer who asked the question. Typically, the customer's email address is retrieved from entry 407 of the customer database record 400 (FIG. 4). In step 1105, the method sends the received answer to the customer at the retrieved email address. In step 1107 the method sends a satisfaction survey to the customer. In this way the customer is able to provide commentary on the services of the consultant who answered the question. Upon completion of step 1107 processing ends in FIG. 11".

Nowhere in these descriptions is it stated that Questions are tagged as a Question message types or that Answers are tagged as an Answer message types. In addition, the claimed feature of providing the message type identifications to users is missing as well.

Thus, the applicants have claimed features not taught in the cited combination, and which have the aforementioned advantages not recognized therein. Accordingly, no prima facie case of obviousness can be established in accordance with the holding of *In Re Fine*. This lack of prima facie showing of obviousness means that the remaining rejected claims are patentable under 35 USC 103(a) over Holtzman in view of Nielsen. As such, it is respectfully requested that the rejection of Claims 1 (which now includes the subject matter of Claim 14), 15, 29 (which now includes the subject matter of Claim 32), and 33 be reconsidered based on the previously-quoted non-obvious claim language.

Summary

In summary, it is believed that the remaining claims are now in condition for allowance. Accordingly, reconsideration of the rejection of Claims 1-12, 15-17, 29,

30 and 33-37, is respectfully requested. In addition, allowance of all these claims at an early date is courteously solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'R. Lyon', written over the printed name.

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